

### **REMARKS**

The Examiner, in paragraph 2 of the Official Action, rejected claims 2-5 and 7 under 35 USC § 112 first paragraph for failing to comply with the enablement requirement. In particular, the Examiner states with regard to claim 2, “the Applicant must provide two separate supports in the original disclosure for a method wherein said micro-discrete indicia is located initially located using an eye-loop and a microscope and for another method wherein said micro-discrete indicia is located initially located using an eye-loop or a microscope.” In this regard Applicant has amended the specification at page 8, line 18 to be consistent with claim 1 as originally filed, thus, no new subject matter has been added. The specification clearly sets forth using normal optical microscope and/or eye loop. In determining the location of the micro-discrete indicia of the present invention, it may be possible to use either an eye-loop and/or microscope. However, it is also possible that one could not use both in locating the micro-discrete indicia.

With regard to the enablement requirement, Applicant respectfully submits that the present invention clearly enables one to practice the invention. It is clear that one can use either an eye-loop and/or a microscope for the initial location. Applicant fails to see anything non-enabling in this language. Further, Applicant respectfully submits that this type of language is appropriate in that it is not indefinite and allowed. Claims must particularly point out and distinctly claim the invention; see MPEP 2173. In this regard, the question is whether the claims meet the threshold requirement of clarity and precision, not whether more suitable language or modes of expression are available; see MPEP 2173.02. Further, as set forth in MPEP 2173.05(h), alternative limitations are allowed. Terminology such as “or” is clearly provided for. With regard to independent claim 3, this claim has been amended to be dependent upon independent claim 1 which further eliminates the locating step of claim 1 to using coordinates associated with the location of said indicia on said gemstone.

In summary, Applicant respectfully submits the claims in their present form meet the requirements of 35 USC § 112 first paragraph.

The Examiner has rejected claims 1-8 under 35 USC § 103(a) as being unpatentable over the combination of Kaplan and further in view of

Kurihara et al. for the reasons set forth in paragraph 4. In this regard, Applicant respectfully submits that the Kaplan reference does not teach or suggest the present invention. As acknowledged in the background of the present invention, the Kaplan reference describes the use of a pulse laser system and mechanical positioning control to mark gemstones and produce a secure certificate of authenticity. The laser in the Kaplan reference operates at a wavelength of 530 nanometers. The present invention is directed to a reading indicia which is substantially smaller in size by magnitudes. As set forth on page 9 of the present application, the size of the indicia is no greater than 20 microns and generally in a range of 2-20 microns. This is a considerable smaller size than that taught by Kaplan. Further Kaplan teaches using lasers for producing and marking. There is no teaching or suggestion of using lasers for reading the gemstone. Quite the contrary, it is believed that the Kaplan reference requires the use of known eye-loops to read the alphanumeric inscription; see column 8, lines 29-35. In the present invention due to the fact that the indicia is substantially smaller than that of Kaplan, it is necessary to first locate the indicium and then secondly read the indicium using near-field optics. Clearly, the Kaplan reference cannot teach or suggest this.

The Examiner acknowledges that Kaplan does not expressly teach reading micro-discrete indicia using near-field optics and relies on Kurihara et al. for teaching the use of near-field optics. However, there is no motivation or suggestion of combining Kurihara et al. with Kaplan. The Kaplan reference is directed to producing indicia on diamonds using a pulsing laser whereas Kurihara et al. is directed to fabrication of functional probes for near-field optical microscopy. The Kurihara et al. article simply discloses the use of near-field optics. The article states "the near-field probes are directed tools to investigate non-linearity in the near-field region." Thus, the Kurihara et al. reference is directed to the fabrication of these tubes that are simply used in near-field optics. It does not teach or suggest the use of near-field optics for reading indicia to which the present invention is directed. In order to combine references there must be some motivation to make the combination. The Kaplan reference is directed to a laser system for producing markings on a gemstone whereas the Kurihara reference is just directed to the production of probes for use in near-field optics microscopy. Since the indicium of Kaplan is substantially greater in size and

discloses the use of an eye-loop for reading such, there would be no motivation or suggestion to use the near-field optics described in Kurihara et al.

The present invention is directed to a two-step process for reading a micro-discrete indicia on a gemstone. Claim 1 specifically sets forth the locating of the micro-discrete indicia on the gemstone and secondly reading the micro-discrete indicia using near-field optics. The locating the micro-discrete indicia is an important factor in that it is extremely small and until it is appropriately located, it cannot be read. Once having located it, there is a requirement for using near-field optics to read the indicia due to its extremely small size. Applicants respectfully submit that the prior art, either individually or in combination, does not teach or suggest the invention as claimed.

With regard to the remaining claims, in particular claim 2, there is no teaching or suggestion in either reference of using a microscope for locating of a discrete indicia.

With regard to claim 3, the Kaplan reference does not teach or suggest locating the indicia using predetermined coordinates. The translation mechanism disclosed in Kaplan is merely used for translating of the device for producing of the marking. While it describes the translation of the work piece in the X, Y and Z coordinate system, there is no teaching of providing coordinates for locating of the indicia as set forth by Applicants in claim 3.

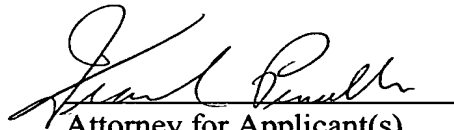
The remaining claims depend at least ultimately upon independent claim 1 and therefore are patentably distinct for the same reasons previously discussed.

The Examiner has also rejected the claims under the non-statutory double patenting created doctrine. However, it is respectfully submitted that in the instant application this is not appropriate. The subject application is a divisional of a parent application Serial No. 10/027,016 which issued to U.S. Patent 6,624,385 which the Examiner relies on for double patenting rejection. In the parent case, a restriction requirement was issued restricting out as Group II claims 19-26 which correspond to the claims as filed in the instant application (see Attachment A). The double patenting rejection under such circumstances is not appropriate as set forth in MPEP 804 as dictated by 35 USC § 121. In view of the foregoing, Applicant respectfully submits that the double patenting rejection in the instant application should be withdrawn.

Applicants herewith enclose a one month extension of time, thus making this response timely filed.

In view of the foregoing it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,

  
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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.

# Attachment A

83891F-P  
Customer No. 01333



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

David L. Patton, et al

METHOD FOR MARKING  
GEMSTONES WITH A UNIQUE  
MICRO DISCRETE INDICIA

Serial No. US 10/027,016

Filed 21 December 2001

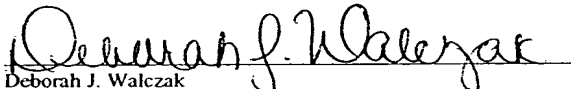
Commissioner for Patents  
Washington, D.C. 20231

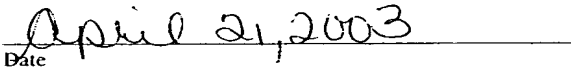
Sir:

Group Art Unit: 1725

Examiner: Samuel M. Heinrich

I hereby certify that this correspondence is being deposited  
today with the United States Postal Service as first class  
mail in an envelope addressed to Commissioner for  
Patents, Washington, D.C. 20231.

  
Deborah J. Walczak


  
Date

## RESPONSE TO REQUIREMENT FOR RESTRICTION AND ELECTION

In response to the restriction requirement set forth in the Official  
Office Action mailed March 28, 2003, Applicants hereby confirm election of  
claims 1-18. The election is made without traverse.

Please cancel non-elected claims 19-32.

Respectfully submitted,

  
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## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,016	12/21/2001	David L. Patton	83891F-P	1145

7590

03/28/2003

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APR - 2 2003

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EXAMINER

HEINRICH, SAMUEL M

ART UNIT

PAPER NUMBER

1725

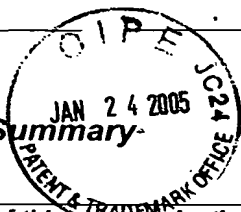
DATE MAILED: 03/28/2003

Entered by NAR

Dec. 4/28/03

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**



Application No.

10/027,016

Applicant(s)

PATTON ET AL.

Examiner

Samuel M Heinrich

Art Unit

1725

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-32 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-18, drawn to indicia marking methods, classified 219/121.69+.
- II. Claims 19-26, drawn to indicia reading methods, classified 235/375+.
- III. Claims 27-32, drawn to gemstones, classified 63/32+.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made with commercially available marking apparatus.

Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used as a gemstone with a micro-roughened surface in place of the instant claimed gemstone having micro-indicia.

This application contains claims directed to the following patentably distinct species of the claimed invention:

Group I, claims 1-18 drawn to processes of marking.



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Group II, claims 19-26 drawn to processes of reading.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel M Heinrich whose telephone number is 703 308 1168. The examiner can normally be reached on M-TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas G Dunn can be reached on 703 308 3318. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9310 for regular communications and 703 872 9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0651.

Samuel M Heinrich  
Primary Examiner  
Art Unit 1725

SMH  
March 26, 2003